

REMARKS

Claims 1-36 are pending in the application. Claims 1-36 stand rejected. Applicant respectfully requests consideration of the following remarks and allowance of the claims.

Amendments to the Abstract and Specification

The Abstract has been amended in accordance with the Examiner's suggestions to delete "JMS/81700-011/188404.1" from the Abstract. Applicant notes that the deleted text is a file reference number from a file management system and does not relate to the content or context of the Abstract.

The Specification has been amended in accordance with the Examiner's suggestions to correct the descriptions of Figures 13-21 and to correct several typographical errors.

Claim Rejections Based Upon 35 U.S.C. § 103(a)

Claims 1-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byers (U.S. Patent No. 5,949,791) in view of Farris et al (U.S. Patent No. 5,592,477). Applicant respectfully disagrees and contends that Byers and Farris, separately and in combination, fail to teach or suggest each and every limitation of the claims. Specifically, Byers does not disclose the elements attributed to it by the Office Action. Additionally, Farris does not disclose the elements attributed to it by the Office Action. Lastly, the combination of Byers and Farris was improperly motivated by hindsight reasoning.

Independent claim 1 requires a signaling processor that processes call signaling to generate and transfer an identifier to an interworking unit. Claim 1 further requires that the interworking unit perform initial voice-band processing if required, and convert voice-band communications into asynchronous communications with the identifier generated and transferred by the signaling processor and with a processing indicator indicating if the voice-band processing was performed. Byers and Farris, separately and in combination, fail to teach or suggest all the limitations of independent claim 1.

Discussion of the Byers Reference

Byers does not disclose a signaling processor that processes call signaling to generate and transfer an identifier for an interworking unit, nor does Byers disclose the interworking unit that converts user communications with the identifier generated by the signaling processor. Rather, Byers discloses a switching system 30 that routes communications from the PSTN to host terminal 32. While host terminal 32 converts the communications from synchronous to asynchronous formats, the switching system 32 already performed the necessary call processing to determine a route for the communications. Thus, the communications were routed to host terminal 32 for transport across the ATM network. Therefore, when host terminal 32 converts the communications, the communications are not converted with an identifier as required by claim 1. Rather, the conversion is a "dumb" conversion whereby the next leg of the route has already been determined (see the SAC 64 of Byers).

Additionally, Byers does not disclose determining if initial voice-band processing is required, and performing the voice-band processing if so required as recited by claim 1. Claim 1 requires that the interworking unit convert the communications with the processing indicator. Thus, the processing indicator is added to the communications *at the interworking point*. Byers does not disclose adding a processing indicator at the interworking point. Rather, as discussed above, Byers discloses a "dumb" interworking point – the SAC 64.

Discussion of the Farris Reference

The Office Action notes that Byers does not disclose an identifier indicated by the first control message and that Farris teaches such an identifier. Applicant contends that Farris does not disclose the identifier indicated by the first control message that Byers lacks.

Farris does not disclose dynamic call routing as described by claims 1-36. Rather, Farris discloses a static one-way path for user communications which originate from video source 110, are interworked by interworking unit 130 into ATM cells and transmitted to host data terminal (HDT) 180. HDT 180 multiplexes the ATM cells and transmits them to ONU 210 which then switches the ATM cells from fiber optic lines to

electrical lines. ONU 210 then transmits the ATM cells over electrical lines to DET 217 and television 217 for viewing. See *Farris*, col. 14, line 64- col. 17, line 45; Fig. 1B, reference no. 101, 120, 130, and 180.

In particular, independent claim 1 requires an interworking unit to *convert user communications into asynchronous communications with an identifier and with a processing indicator*. The *identifier* is generated by the signaling processor after *receiving call signaling*. *Farris* only discloses an ATM cell stream statically addressed for a destination HDT 180. Interworking unit 130 receives video from an encoder 120 and automatically converts the video into ATM cells and sends the cells to HDT 180 (*Farris*, col. 16, lines 25-40). Interworking unit 130 always addresses the ATM cells for the HDT- the ATM cells are *not* dynamically addressed based on a selected identifier as required by claim 1. Furthermore, the ATM cells are not addressed in response to *call signaling* as required by claim 1.

Additionally, *Farris* does not disclose a *signaling processing system configured to receive and process call signaling to generate and transfer the identifier* as required by claim 1. The interworking unit 130 of *Farris* does not address the ATM cells using an identifier generated based on signaling for user communications. DET 217 transmits signaling to ONU 210 and HDT 180, but neither ONU 210 nor the HDT 180 selects an identifier for interworking unit 130 based on the signaling from DET 217.

Improper Combination of References

The Office Action also states that it would have been obvious to combine Byers with *Farris* and that the motivation to combine would be to make *Farris* more efficient. The Office Action improperly combines Byers with *Farris* to reject the claims as obvious.

The mere fact that two references can be combined or modified does not render the combination obvious unless the prior art suggests the desirability of the combination (See MPEP § 2143.01). In this case, the Office Action has not shown how the prior art suggests the desirability of combining Byers and *Farris*. The Office Action fails to state how either Byers or *Farris* suggests such a combination and fails to state how or why one skilled in the art would suggest the combination of *Farris* and Reese.

The Office Action's conclusion of obviousness improperly takes into account knowledge gleaned from applicant's disclosure and is therefore an improper conclusion of obviousness based on improper hindsight reasoning (*See* MPEP §2145.X.A). The Office Action gleans the advantages of adding an identifier and a processing indicator at the interworking point from the disclosure and improperly applies the advantages to Farris and Reese.

Specifically, The Office Action acknowledges that Byers does not disclose an identifier indicated by the first control message (Office Action, page 4, lines 5-6). The Office Action then states that Farris, in the same field of endeavor, teaches such an identifier included with the control message. Additionally, the Office Action explains that the desire to make Byers more "efficient" would motivate one skilled in the art to combine Byers with Farris (note, the Office Action reads "Ferris" at page 4, line 20. Applicant assumes the phrase should correctly read "Byers"). However, the Office Action does not explain why the identifier included in the control message would make Byers more efficient. Furthermore, the Office Action does not explain why one skilled in the art would know that the identifier included with the control message would make Farris more efficient. Lastly, the Office Action does not provide support in either Byers or Farris for the conclusion that adding the identifier included with the control message to Byers would make Byers more efficient.

Remaining Independent and Dependent Claims

Independent claims 11, 19, and 29 contain limitations similar to those of claim 1 and are therefore allowable for at least the same reasons as claim 1. While the dependent claims contain limitations rendering them separately allowable over the art of record, applicant forgoes such a discussion for the sake of brevity in view of the dependent claims depending from allowable independent claims.

CONCLUSION

The claims in their present form are allowable over the art of record. Applicant therefore solicits their allowance.


SIGNATURE OF PRACTITIONER

Stephen S. Roche, Reg. No. 52,176
Duft Setter Ollila & Bornsen LLC
Telephone: (303) 938-9999 ext. 15
Facsimile: (303) 938-9995

Correspondence address:

CUSTOMER NO. 28004

Attn: Harley R. Ball
6391 Sprint Parkway
Mailstop: KSOPHT0101-Z2100
Overland Park, KS 66251-2100